

## REMARKS

Claims 1-60 are pending in the application. The Examiner has withdrawn the original grounds for restriction (imposed in Paper No. 9) in response to Applicants' timely traversal and the arguments presented therein.

The Examiner has imposed a new restriction requirement in this case. In particular, the Examiner states:

"Claims 1, 20, 39 and 58-60 generic to a plurality of disclosed patentably distinct species comprising:

- I. Claims 2-8, 10-12, 14-16, 18-19, 21-27, 29-31, 33-35, 37-38, 40-46, 48-50, 52-54 and 56-57 pertain to a method...for registering a consumer, including the consumer's desired list of websites...(first species).
- II. Claims 9, 13, 17, 28, 32, 36, 47, 51 and 55 pertain...to...another method or another embodiment for creating interest categories...based on the interests of other consumers that have similar interests as the consumer, ...and wherein the system is used to at least present targeted advertising information to the consumer (second species)."

(Paper No. 11, pg. 2).

Applicants provisionally elect to prosecute Species I (including species claims 2-8, 10-12, 14-16, 18-19, 21-27, 29-31, 33-35, 37-38, 40-46, 48-50, 52-54 and 56-57 as well as the generic claims 1, 20, 39, and 58-60). This provisional election is made with traverse. That is, Applicants respectfully disagree with the Examiner's proposed restriction. Applicants request reconsideration of the restriction requirement in light of the following arguments, and pursuant to 37 C.F.R. §1.143.

***1) The Examiner has Failed to Establish a Prima Facie Case for Restriction***

Restriction of the pending claims is not believed to be appropriate in this case. Specifically, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case for restriction.

**a) Proper Basis for Restriction**

**i) Generally**

Restriction is proper only where an application contains claims directed to two or more independent or distinct inventions. (MPEP §802.01). The term "independent" is defined as meaning "that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect". (MPEP §802.01). To establish a *prima facie* case for restriction where the basis for restriction is that the different inventions being claimed are "independent", the Examiner must demonstrate "the reasons...why the inventions as claimed are...independent". (MPEP §808). The term "distinct", as used in restriction practice, means that two or more claimed subjects are "(1) capable of separate manufacture, use or sale; and (2) are patentable over each other". (*Id.*). To establish a *prima facie* case for restriction where the basis for restriction is that the inventions are "distinct", the Examiner must establish (1) "the reasons (as distinguished from the mere statement of conclusion) why the inventions *as claimed* are...distinct", and (2) "the reasons for insisting upon restriction therebetween". (MPEP §808).

**b) The Examiner's Case as Set Forth**

The Examiner fails to provide *any* support for the present restriction. The Examiner makes no statement as to why the alleged species are believed to be distinct. Accordingly, the Examiner fails to satisfy the burden of establishing a *prima facie* case for restriction under MPEP §808, for either "independent" or "distinct"-based restrictions.

**c) A *Prima Facie* Case for "Distinct" Restriction has not been Established**

No reasons for believing the claimed inventions are "distinct" have been set forth, nor has the second requirement of presenting reasons for insisting upon restriction been complied with.

The Examiner has failed to show that (1) that each claimed invention "has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search", (2) that even if classified together they have formed separate subjects for inventive effort, or (3) that a different field of search is required. (MPEP §808.02). Absent such showings as required by MPEP §808.02, no *prima facie* case for restriction under the "distinct" theory is established. Where "the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions." (*Id.*).

**2) *The Examiner has Failed to Establish an Undue Burden***

Even if a *prima facie* case for restriction establishes that an application includes independent or distinct inventions, restriction is not proper "[i]f the search and examination of [the] entire application can be made without serious burden." (MPEP §803). Applicants respectfully assert that restriction is not proper in this case because there is no indication that any serious burden exists. In particular, (1) there is no separate classification of the alleged Species which would necessitate a separate field of search; (2) the alleged Species can be searched using the same field of search without unduly burdening the Examiner; and (3) the alleged Species are not related to any class of invention which has achieved a separate status in the art. (see, MPEP §808.02). In general, Applicants believe that the claims all can readily be searched and examined together without undue burden on the Examiner. Thus, even if the Examiner had set forth a *prima facie* case for restriction and had relied upon proper grounds for restriction, restriction would still not be proper in this case.

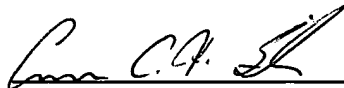
**3) *Conclusion***

In view of the foregoing, Applicants respectfully request that the restriction requirement be withdrawn upon reconsideration. All claims currently remain in the case and are believed patentable. Applicants respectfully request allowance of the pending claims.

If any issues remain, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is kindly invited to contact Carson C.K. Fincham using the information provided below.

Respectfully submitted,

August 11, 2004  
Date



---

Carson C.K. Fincham  
Registration No. 54,096  
Buckley, Maschoff & Talwalkar LLC  
5 Elm Street  
New Canaan, CT 06840  
(203) 972-4982